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EXAMINER

LY, NGHI H

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 06/26/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/758,356

Applicant(s)

ACUNA, VICTOR E.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9,12-16 and 18-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9,12-16,18-25,31,34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 26-30, 32 and 33 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "number 16" as described in the specification (page 9, line 23). Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "number 20 " has been used to designate both "voice mail" and "central platform". Correction is required.

### ***Election/Restrictions***

2. Newly submitted claims 26-30, 32 and 33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 26 and 30 drawn to generating an automatic call, claims 27-29 drawn to error detection and claims 32 and 33 drawn to editing text.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-30, 32 and 33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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***Claim Rejections - 35 USC § 112***

3. Claims 18, 19 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 18, it recites "segmentation group".

Regarding claims 19 and 21, they recite "a header".

Therefore, claims 18, 19 and 21 contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-17, 20, 22-24, 31, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker et al (US 5,832,378) in view of Payne et al (US 6,167,426).

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Regarding claims 1, 7, 12, 14, 16, 20, 22-24, 31, 34 and 35, Zicker teaches a dual signaling channel telephone system, comprising: a wired signaling channel (see fig.1 number 24) including a central office (see fig.1 PSTN 20) and a telephone set (see fig.1 a telephone set connect to RJ-11 box,) to place and receive wire-line telephone calls (see fig.1 wire-line connection 24 between PSTN 20 and a telephone which connect with RJ11), a wireless signaling channel including a central platform (see fig.1 number 12), the central platform receiving (see fig.1 wireless connection between 10b and 26) messages from a message generator (see fig.1 number 23) independently operated from the telephone system (see fig.1 the wire-line connection 24 between PSTN 20 and a telephone set which connect with RJ11 operating independently form the wireless connection between 10b and 26), and generating a radio frequency signal (see fig.1 number 10b), and to broadcast the messages to a telephone set (see fig.1 the zigzag line between 10b and base station 26), the messages are not related to control and program signaling of the telephone set (also see fig.1 the wire-line connection 24 between PSTN 20 and a telephone set which connect with RJ11 is operated independently from the wireless connection between 10b and box 26. Therefore, the messages are not related to control and program signaling of the telephone set). Zicker does not specifically disclose the wired signaling channel and the wireless signaling channel are used for the calls and the messages and are configured to operate during the same communication.

Payne teaches the wired signaling channel and the wireless signaling channel are used for the calls and the messages and are configured to operate during the same

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communication (see abstract, "at the same time automatically launching any required browser or application software"). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention was made to provide the above teaching of Payne into the system Zicker so that any required browser or application software could have been launched immediately by the service provider.

Regarding claim 2, the combination of Zicker and Payne further teaches the messages are conveyed to the telephone set and include indications, notifications or any information content for delivering via voice mail, e-mail, fax and internet (see Payne column 1 lines 25-30 and column 4 lines 65-67).

Regarding claim 3, Zicker further teaches that the wireless signaling channel transmits signals independently (see fig.1 the wireless connection between 10b and base station 26).

Regarding claims 4-6, the combination of Zicker and Payne further teaches an indicating device (see Payne, abstract).

Regarding claim 8, Zicker further teaches the messages are supplied to the network in at least one format (see fig.1 the X.25 connection between number 17 and number 23).

Regarding claim 9, the telephone in Zicker inherently includes the limitation "audibly" or "visually".

Regarding claims 10 and 17, Zicker further teaches a central platform for use in dual signaling channel telephony network, the central platform comprising: the first processor (see fig.1 number 20) to receive incoming messages and transmitted over a

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wireless channel (see fig.1 wireless connection between 10b and 26), and a central processor authenticating relevant portions of the messages (see column 15, lines 43-51), and a second processor (see fig.1 number 12), and the message are not related to control and program signaling of the telephone set (see fig.1 the wire-line connection 24 between PSTN 20 and a telephone set which connect with RJ11 is operated independently from the wireless connection between 10b and box 26. Therefore, the messages are not related to control and program signaling of the telephone set).

Regarding claim 11, Zicker further teaches a RF translator (see fig.1, block 10b), a server including a database storing user profiles and related information (see fig.1 number 23).

Regarding claim 13, Zicker further teaches the output device is at least one of a speaker (see fig.1 the telephone).

Regarding claim 15, Zicker further teaches the message from a network accessible device to a central platform (see fig.1 connection of box 12 with PSTN 20 and PC 16), and delivering the message received by the telephone on an output of the telephone (see fig.1 antenna of box 26 and line 24).

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker et al (US 5,832,378) in view of Kikinis (US 6,483,905).

Regarding claim 25, Zicker teaches a method of communication over a dual signaling channel system (see Zicker fig.1 a telephone connected to a wireless base station 26 and a PSTN 20). Zicker does not specifically disclose broadcasting short

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wireless messages to administer stored messages in a dual channel telephone set to be exhibited on screen. Kikinis teaches broadcasting short wireless messages to administer stored messages set to be exhibited on screen (see column 2 line 65 to column 3 line 2). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to provide the above teaching of Kikinis to the system Zicker in order to alert the user of any sorts of messages waiting to be reviewed.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-17, 20, 22-25, 31, 34 and 35 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Nghi H. Ly



June 22, 2003



WILLIAM TROST  
SUPERVISORY PATENT EXAMINER  
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